

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application:)	
)	
Application No.: 09/899,182)	
)	Group Art Unit: 3751
Filed: July 6, 2001)	
)	Examiner: K. Huynh
Reissue of U.S. Patent No.: 5,918,994)	
)	
Inventor: Jean-Louis H. Gueret)	
)	
Issued: July 6, 1999)	Confirmation No.: 9798
)	
For: NOTCHED BRUSH AND MAKE-UP)	
DEVICE INCLUDING THIS BRUSH)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTAL DECLARATION OF JEAN-LOUIS H. GUERET

I, Jean-Louis H. Gueret, hereby declare that:

1. My residence, post office address and citizenship are as stated below under my name.
2. I believe I am the original, first, and sole inventor of the subject matter claimed in U.S. Patent No. 5,918,994 and in the above-identified reissue patent application.
3. I have reviewed and understand the contents of the above-identified reissue application, including the originally-filed claims and the claims added and amended in the Preliminary Amendment filed on August 10, 2001, the Amendment filed on November 14, 2006, and the Amendment filed on May 16, 2007.
4. I acknowledge the duty to disclose information material to patentability in accordance with Title 37, Code of Federal Regulations, Section 1.56.

5. I hereby claim the benefits of foreign priority under Title 35, United States Code, section 119 of French Patent Application No. 96 06515, filed May 24, 1996.

6. I believe that U.S. Patent No. 5,918,994 is partially inoperative by reason of my having claimed less than I had a right to claim. Independent claim 1 of U.S. Patent No. 5,918,994 recites a brush comprising, *inter alia*, at least one notch comprising at least two secant faces that "form a reentrant angle (β) of between 60° and 180° at any point along" a trough line. Certain aspects of the invention could be practiced without having such a configuration.

7. I believe that U.S. Patent No. 5,918,994 is also partially inoperative by reason of my having claimed more than I had a right to claim in certain aspects.

8. All errors being corrected in the reissue application up to the time of filing of the present Declaration arose without any deceptive intention on my part.

9. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the reissue application or any patent issuing thereon.

Jean-Louis H. Gueret Date: 10-19-06-08
Jean-Louis H. Gueret

Citizenship: French

Residence and Post Office Address:

27 rue Raymond Poincaré
75116 PARIS



PATENT
Customer No. 22,852
Attorney Docket No. 5725.0701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)	
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Jean-Louis H. GUERET)	Group Art Unit: 3751
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Application No.: 09/899,182)	Examiner: K. Huynh
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Filed: July 6, 2001)	
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For: NOTCHED BRUSH AND MAKE-UP)	Confirmation No.: 9798
DEVICE INCLUDING THIS BRUSH)	

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. §§ 1.144 AND 1.181
REGARDING ELECTION OF SPECIES REQUIREMENTS

Applicant respectfully petitions the Director of Technology Center 3700 to review the election of species requirements mailed on March 22, 2006 and reconsider the Examiner's final decision to improperly withdraw certain claims from further examination. In accordance with 37 C.F.R. §§ 1.144 and 1.181, this petition is being filed after the requirement was made final by the Examiner, but prior to the filing of an appeal.

I. Relief Requested

This petition is brought on the ground that the Examiner's withdrawal of certain pending claims is improper. Specifically, Applicant respectfully submits that the Examiner's withdrawal of at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116,

117, 120-124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 is improper because these claims either read on the elected species or were not subject to any of the species-election requirements asserted in the Office Action dated March 22, 2006. Thus, Applicant respectfully requests reconsideration of the election of species requirements and reinstatement of at least these improperly withdrawn claims.

II. Election of Species Requirements of March 22, 2006

In the Office Action mailed on March 22, 2006 (attached as Exhibit A), the Examiner has applied the following six election of species requirements under 35 U.S.C. § 121:

First Requirement

Species 1A: allegedly drawn to a species wherein “another” notch is the “second” notch; and

Species 1B: allegedly drawn to a species wherein “another” notch is not the “second” notch.

Second Requirement

Species 2A: allegedly drawn to a species wherein the faces of the notch extend from one end of the brush to the other; and

Species 2B: allegedly drawn to a species wherein the faces of the notch extend along only a part of a length of the brush.

Third Requirement

Species 3A: allegedly drawn to a species wherein the notch back is convex (original claim 19); and

Species 3B: allegedly drawn to a species wherein the notch back is planar.

Fourth Requirement

Species 4A: allegedly drawn to the brush shape shown in Figs. 1A, 2, and 3;

Species 4B: allegedly drawn to the brush shape shown in Fig. 6;

Species 4C: allegedly drawn to the brush shape shown in Fig. 7;

Species 4D: allegedly drawn to the brush shape shown in Fig. 8;

Species 4E: allegedly drawn to the brush shape shown in Fig. 9; and

Species 4F: allegedly drawn to the brush shape shown in Fig. 10.

Fifth Requirement

Species 5A: allegedly drawn to a species wherein the trough line is straight; and

Species 5B: allegedly drawn to a species wherein the trough line is curved.

Sixth Requirement

Species 6A: allegedly drawn to a species wherein the peak ridge is straight; and

Species 6B: allegedly drawn to a species wherein the peak ridge is curved.

In connection with the First Requirement, the Examiner asserted that claims 89, 132, 203, and 266 correspond to Species 1A and that claims 90, 133, 204, and 267 correspond to Species 1B. See Exhibit A at 3.

Regarding the five remaining requirements, the Examiner asserted that Applicant had constructively elected particular species based on the originally patented claims. See Exhibit A at 3-6. Specifically, the Examiner asserted that Applicant constructively elected Species 2A(original claim 4), Species 3A (original claim 19), Species 4A (original claim 10), Species 5A (original claim 15), and Species 6A (original claim 18). Based on these alleged constructive elections, the Examiner indicated that claims 98, 104, 108, 115, 118, 119, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 278, 282, 287, 289, and 314-319 are

withdrawn from consideration “as being directed to an invention non-elected by original presentation.” See Exhibit A at 6.

III. Applicant’s Response to March 22, 2006 Requirements

In response to the March 22, 2006 Office Action, Applicant filed a Response to Election of Species Requirements (attached as Exhibit B) on April 24, 2006. In that Response, Applicant elected Species 1A (i.e., claims 89, 132, 203, and 266) for initial prosecution in this application.

Since the election was between Species 1A (alleged to be covered by claims 89, 132, 203, and 266) and Species 1B (alleged to be covered by claims 90, 133, 204, and 267), Applicant’s election of Species 1A should have resulted in withdrawal of only claims 90, 133, 204, and 267, in addition to the claims withdrawn by the Examiner as being allegedly drawn to “an invention non-elected by original presentation” (i.e., claims 98, 104, 108, 115, 118, 119, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 278, 282, 287, 289, and 314-319).

Consequently, Applicant’s election of Species 1A and Applicant’s alleged constructive elections should have resulted in withdrawal of only claims 90, 98, 104, 108, 115, 118, 119, 133, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 204, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 267, 278, 282, 287, 289, and 314-319.

IV. Examiner’s Erroneous Claim Withdrawal and Failure to Fully Respond to Applicant’s Repeated Requests for Reconsideration

Nonetheless, in the Office Action mailed on August 15, 2006 (attached as Exhibit C), the Examiner withdrew claims 85-87, 90-124, 128-130, 133-167, 171-198,

204-230, 234-261, 267-293, 302-307, 314-319, and 326-331, as being allegedly drawn to non-elected inventions. In support of his unwarranted claim withdrawal, the Examiner appeared to allege that Applicant had indicated that claims 89, 132, 203, and 266 are readable on elected Species 1A and that all of the other claims could be withdrawn as being drawn to "the non-elected inventions." See Exhibit C at 2. Applicant respectfully disagrees.

As mentioned above, the Examiner's first election of species requirement was between Species 1A and Species 1B only. Accordingly to the Examiner's characterizations, claims 89, 132, 203, and 266 cover Species 1A and claims 90, 133, 204, and 267 cover Species 1B, and the Examiner's election requirement essentially required Applicant to elect between claims 89, 132, 203, and 266 and claims 90, 133, 204, and 267. Consequently, Applicant's election of Species 1A should have resulted in withdrawal of the Species 1B claims only (i.e., claims 90, 133, 204, and 267), in addition to those claims allegedly drawn to "an invention non-elected by original presentation." Specifically, only claims 90, 98, 104, 108, 115, 118, 119, 133, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 204, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 267, 278, 282, 287, 289, and 314-319 should have been withdrawn from consideration as a result of the Examiner's election of species requirements of April 22, 2006 and Applicant's response filed April 24, 2006.

All of the other pending claims were either "readable" on the elected species or not subject to any of the election of species requirements at all and should have remained in the application for further examination. Those erroneously withdrawn claims include at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-

124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331.

Applicant has repeatedly requested the Examiner to reconsider his erroneous claim withdrawals. See, e.g., Applicant's Remarks filed November 14, 2006 (attached as Exhibit D) and May 16, 2007 (attached as Exhibit E). To date, the Examiner has not replied to Applicant's Remarks or otherwise addressed the issue since the August 15, 2006 Office Action. See, e.g., Office Action mailed on February 16, 2007 (attached as Exhibit F).

V. Conclusion

In view of the foregoing reasons, Applicant respectfully submits that the Examiner's withdrawal of certain pending claims was made in error and that Applicant should be entitled to the examination on the merits of those erroneously withdrawn claims. Thus, Applicant respectfully requests the Director to review the election of species requirements of March 22, 2006 and the Examiner's subsequent claim withdrawal and reinstate at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 for examination on the merits in this application.


Please grant any extensions of time required to enter this petition and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 20, 2008

By:


K. Kevin Mun
Reg. No. 50,585
(571) 203-2739



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,182	07/06/2001	Jean-Louis H. Gueret	5725.0701	9798
22852	7590	03/22/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			DEVORE, PETER T	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/899,182	GUERET, JEAN-LOUIS. H.	
	Examiner	Art Unit	
	Peter T. deVore	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-335 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-335 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Oath/Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: the declaration incorrectly identifies the Application number of the present Application as 09/889,182.

Upon action on the merits of the present Application, all pending claims will be rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 for the reason set forth above unless/until the defective declaration is cured. See 37 CFR 1.175.

Election/Restrictions

As a first matter, note that all of the newly added independent claims are broader in at least one aspect than all of the originally patented claims because they are all silent as to the reentrant angle of the two secant faces.

This application contains claims directed to the following patentably distinct sets of species.

1st set:

Species 1A, drawn to a species wherein the "another" notch is the "second" notch,

Species 1B, drawn to a species wherein the "another" notch is not the "second" notch.

Species 1A and 1B are independent or distinct because the product application properties of brushes are highly dependent on the spatial relationships of the notches.

All of the originally patented claims are generic to this feature, and all of the newly added independent claims are also generic to this feature. Therefore, Applicant is required to elect one of Species 1A and 1B, and those claims which are directed to the non-elected species and which depend from a newly added independent claim will be withdrawn from consideration because the newly added independent claims are all broader in at least one aspect than all of the originally patented claims as discussed supra. Specifically, claims 89, 132, 203, and 266 correspond to Species 1A and depend from newly added independent claims, and claims 90, 133, 204, and 267 correspond to Species 1B and depend from newly added independent claims.

2nd set:

Species 2A, drawn to a species wherein the faces of the notch extend from one end of the brush to the other,

Species 2B, drawn to a species wherein the faces of the notch extend along only a part of a length of the brush.

Species 2A and 2B are independent or distinct because the product application properties of brushes are highly dependent on the dimensions of the notches.

Of the originally patented claims, only claim 4 speaks to this feature; claim 4 is specific to Species 2A. Therefore, Applicant has elected Species 2A by original presentation, and all of the claims which are specific to Species 2B and which depend from a newly added independent claim, specifically claims 98, 141, 177, 210, and 240, are withdrawn from consideration because the newly added independent claims are all

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broader in at least one aspect than all of the originally patented claims as discussed supra.

3rd set:

Species 3A, drawn to a species wherein the notch back is convex,

Species 3B, drawn to a species wherein the notch back is planar.

Species 3A and 3B are independent or distinct because the product application properties of brushes are highly dependent on the shapes of the notches.

Of the originally patented claims, only claim 19 speaks to this feature; claim 19 is specific to Species 3A. Therefore, Applicant has elected Species 3A by original presentation, and all of the claims which are specific to Species 3B and which depend from a newly added independent claim, specifically claims 104, 147, 182, 215, 245, and 278 are withdrawn from consideration because the newly added independent claims are all broader in at least one aspect than all of the originally patented claims as discussed supra.

4th set:

Species 4A, drawn to the brush shape shown in Figures 1A, 2, and 3,

Species 4B, drawn to the brush shape shown in Figure 6,

Species 4C, drawn to the brush shape shown in Figure 7,

Species 4D, drawn to the brush shape shown in Figure 8,

Species 4E, drawn to the brush shape shown in Figure 9,

Species 4F, drawn to the brush shape shown in Figure 10.

Species 4A-4F are independent or distinct because the product application properties of brushes are highly dependent on the shapes of the brushes.

Of the originally patented claims, only claim 10 speaks to this feature; claim 10 is specific to Species 4A. Therefore, Applicant has elected Species 4A by original presentation, and all of the claims which are specific to any of Species 4B-4F and which depend from a newly added independent claim, specifically claims 108, 151, 186, 219, 249, 282, and 314-319 are withdrawn from consideration because the newly added independent claims are all broader in at least one aspect than all of the originally patented claims as discussed supra.

5th set:

Species 5A, drawn to a species wherein the trough line is straight,

Species 5B, drawn to a species wherein the trough line is curved.

Species 5A and 5B are independent or distinct because the product application properties of brushes are highly dependent on the shapes of the trough lines.

Of the originally patented claims, only claim 15 speaks to this feature; claim 15 is specific to Species 5A. Therefore, Applicant has elected Species 5A by original presentation, and all of the claims which are specific to Species 5B and which depend from a newly added independent claim, specifically claims 115, 158, 191, 224, 254, and 287 are withdrawn from consideration because the newly added independent claims are all broader in at least one aspect than all of the originally patented claims as discussed supra.

6th set:

Species 6A, drawn to a species wherein the peak ridge is straight,

Species 6B, drawn to a species wherein the peak ridge is curved.

Species 6A and 6B are independent or distinct because the product application properties of brushes are highly dependent on the shapes of the peak ridges.

Of the originally patented claims, only claim 18 speaks to this feature; claim 18 is specific to Species 6A. Therefore, Applicant has elected Species 6A by original presentation, and all of the claims which are specific to Species 6B and which depend from a newly added independent claim, specifically claims 118, 119, 161, 162, 193, 226, 256, and 289 are withdrawn from consideration because the newly added independent claims are all broader in at least one aspect than all of the originally patented claims as discussed supra.

Accordingly, claims 98, 104, 108, 115, 118, 119, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 278, 282, 287, 289, and 314-319 are withdrawn from consideration as being directed to an invention non-elected by original presentation, and upon Applicant's election of Species 1A or Species 1B, additional claims will be withdrawn from consideration as being drawn to a non-elected invention as discussed supra and following such election the Examiner will issue an Office Action on the merits of the claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter T. deVore whose telephone number is (571) 272-4884. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pd Pd

Pd Pd



TFW

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0701

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Jean-Louis H. GUERET) Group Art Unit: 3751
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Application No.: 09/899,182) Examiner: Peter T. deVore
)
Filed: July 6, 2001)
) Confirmation No.: 9798
For: NOTCHED BRUSH AND MAKE-)
UP DEVICE INCLUDING THIS)
BRUSH)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO ELECTION OF SPECIES REQUIREMENTS

In an Office Action dated March 22, 2006, the period for response to which extends to April 24, 2006 (as April 22, 2006, was a Saturday), the Examiner has applied a series of six species-election requirements.

In the first species-election requirement, the Examiner has required Applicant to elect between the following two allegedly distinct species:

Species 1A – a species wherein the “another” notch is the “second” notch; and

Species 1B – a species wherein the “another” notch is not the “second” notch.

In connection with this species-election requirement, the Examiner asserted that claims 89, 132, 203, and 266 correspond to Species 1A, and that claims 90, 133, 204, and 267 correspond to Species 1B. (Office Action at 2.) The Examiner acknowledged,

however, that all of the originally patented claims, and all of the newly added independent claims, are generic to both Species 1A and Species 1B. (*Id.* at 3.)

In response to the Examiner's first species-election requirement, Applicant elects Species 1A (i.e., claims 89, 132, 203, and 266) for initial prosecution in the application. Upon allowance of a generic claim, however, Applicant requests that the Examiner examine and allow the claims identified in the Office Action as corresponding to Species 1B.

The Examiner also applied five other species-election requirements, but held that Applicant had constructively elected particular species based on the originally patented claims. (Office Action at 3-6.) Specifically, the Examiner asserted that Applicant constructively elected Species 2A (original claim 4), Species 3A (original claim 19), Species 4A (original claim 10), Species 5A (original claim 15), and Species 6A (original claim 18). Based on these species-election requirements, the Examiner has withdrawn claims 98, 104, 108, 115, 118, 119, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 278, 282, 287, 289, and 314-319.

Applicant notes that at least claim 84 is generic to withdrawn claims 98, 104, 108, 115, 118, and 119; that at least claim 127 is generic to withdrawn claims 141, 147, 151, 158, 161, and 162; that at least claim 170 is generic to withdrawn claims 177, 182, 186, 191, and 193; that at least claim 201 is generic to withdrawn claims 210, 215, 219, 224, and 226; that at least claim 233 is generic to withdrawn claims 240, 245, 249, 254, and 256; and that at least claim 264 is generic to withdrawn claims 278, 282, 287, 289, and

314-319. Upon allowance of a generic claim, Applicant requests that the Examiner rejoin, examine, and allow the respective withdrawn claims.

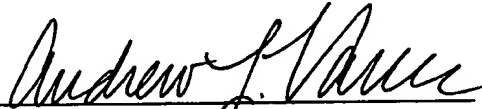
Applicant also notes that the Examiner identified a minor typographical error in the reissue declaration with respect to the application number. Applicant appreciates the Examiner's identification of this typographical error and intends to submit a corrected declaration to address it.

Please grant any extensions of time required to enter this response and charge any required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 24, 2006

By: 
Andrew J. Vance
Reg. No. 45,174



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,182	07/06/2001	Jean-Louis H. Gueret	5725.0701	9798

22852 7590 08/15/2006

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EXAMINER

HUYNH, KHOA D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/899,182	Applicant(s) GUERET, JEAN-LOUIS H.	
	Examiner Khoi D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-331 is/are pending in the application.
 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-83, 296-301, 308-313 and 320-325 is/are allowed.
- 6) ☒ Claim(s) 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294 and 295 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/02/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 85-87,90-124,128-130,133-167,171-198,204-230,234-261,267-293,302-307,314-319 and 326-331.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species 1A in the reply filed on 04/24/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant, in the reply, indicates that claims 89, 132, 203 and 266 are readable on elected Species 1A. Furthermore, the reply indicates that all of the originally patented claims and all of the newly added independent claims are generic to elected Species 1A. Accordingly, claims 85-87, 90-124, 128-130, 133-167, 171-198, 204-230, 234-261, 267-293, 302-307, 314-319 and 326-331 are withdrawn from further consideration as being drawn to the non-elected inventions.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the back face of the at least one notch is defined by bristles having varying lengths as recited in claims 84 and 127 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 84 and 127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both claims 84 and 127 recite the limitation "the back face of the at least one notch is defined by bristles having varying lengths". However, such claimed subject matter was not described in the original specification. In the original instant disclosure, applicant discloses (col. 3, lines 6-11) that the bristles of

the brushes may be of any type: bristles with different heights, different diameters or cross-sections and made of different materials. Nevertheless, the original disclosure does not disclose that the back face of the at least one notch is defined by bristles having varying lengths. Therefore, claims 84 and 127 contain subject matter that constitutes new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 84, 88, 89, 125-127, 131, 132, 168 and 169 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Both claims 84 and 127 recite the limitations "the back face of the at least one notch is defined by bristles having varying lengths". However, such recitations render the claims indefinite because the claimed subject matter does not have any support in the instant specification. Since the claims do not clearly set forth the metes and bounds of the patent protection desired, the scope of the claims is unascertainable. Claims 88, 89, 125, 126, 131, 132, 168 and 169 depend on claims 84 and 127 and are likewise indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294 and 295, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery (4403624).

Regarding claim 84, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 88 and 89, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 125 and 126, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 127, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 131 and 132, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 168 and 169, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 170, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 199 and 200, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 201, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13)

form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constituted by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 202 and 203, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 231 and 232, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 233, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constituted by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and

back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 262 and 263, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 264, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the back face

of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 265 and 266, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 294 and 295, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Allowable Subject Matter

9. Claims 1-29 (previously allowed claims), 30-83, 296-301, 308-313 and 320-325 (newly added dependent claims that depend on claims 1-29) are allowed over the prior art of record.

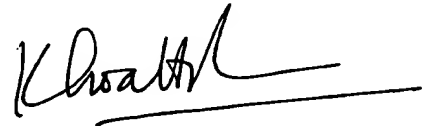
Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'K. Huynh', with a horizontal line extending to the right.

Khoa D. Huynh
Primary Examiner
Art Unit 3751

HK
08/10/06

REMARKS

By this Amendment, claims 333 and 335 have been amended to correct minor informalities. Since the minor informalities were readily apparent, the corrections do not narrow the claim scope.

Claims 1-335 are pending in the application, of which claims 1, 24, 26, 27, 28, 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335 are independent. Claims 1-83, 296-301, 308-313, and 320-325 have been allowed.

For the following reasons, Applicant respectfully requests reconsideration of this application and withdrawal of the objection and rejections outstanding in the August 18, 2006, Office Action.

As an initial matter, Applicant respectfully notes that the Office Action did not address claims 332-335, which were submitted in the Preliminary Amendment filed on August 10, 2001. These claims read on the elected species and therefore should have been examined. Accordingly, Applicant respectfully requests that the Office consider the August 10, 2001, Preliminary Amendment and examine claims 332-335. If the Office intends to reject any of those claims in any subsequent Office Action, Applicant respectfully requests that the Office set forth a detailed explanation of the basis for any such rejection and make that Office Action non-final to provide Applicant with a full and fair opportunity to respond.

Applicant also notes that the Office has withdrawn claims 85-87, 90-124, 128-130, 133-167, 171-198, 204-230, 234-261, 267-293, 302-307, 314-319, and 326-331 from consideration, as allegedly being directed to non-elected species. (Office Action at 2.) Applicant respectfully submits, however, that the withdrawal of at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-

150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 is improper, because these claims either read on the elected species or were not subject to any of the species-election requirements applied in the Office Action dated March 22, 2006.

More specifically, in the Office Action dated March 22, 2006, the Office applied the following six species-election requirements:

1	<p><u>1A</u>: a wherein the "another" notch is the "second" notch (claims 89, 132, 203, and 266); and</p> <p><u>1B</u>: a wherein the "another" notch is not the "second" notch (claims 90, 133, 204, and 267).</p>
2	<p><u>2A</u>: a wherein the faces of the notch extend from one end of the brush to the other (original claim 4); and</p> <p><u>2B</u>: a where the faces of the notch extend along only a part of a length of the brush (claims 98, 141, 177, 210, and 240).</p>
3	<p><u>3A</u>: a wherein the notch back is convex (original claim 19); and</p> <p><u>3B</u>: a where the notch back is planar (claims 104, 147, 182, 215, 245, and 278).</p>
4	<p><u>4A</u>: a directed to the brush shape shown in Figs. 1A, 2, and 3 (original claim 10);</p> <p><u>4B</u>: a directed to the brush shape shown in Fig. 6;</p> <p><u>4C</u>: a directed to the brush shape shown in Fig. 7;</p> <p><u>4D</u>: a directed to the brush shape shown in Fig. 8;</p> <p><u>4E</u>: a directed to the brush shape shown in Fig. 9; and</p> <p><u>4F</u>: a directed to the brush shape shown in Fig. 10.</p>
5	<p><u>5A</u>: a wherein the trough line is straight (original claim 15); and</p> <p><u>5B</u>: a wherein the trough line is curved (claims 115, 158, 191, 224, 254, and 287).</p>
6	<p><u>6A</u>: a wherein the peak ridge is straight (original claim 18); and</p> <p><u>6B</u>: a where the peak ridge is curved (claims 118, 119, 161, 162, 193, 226, 256, and 289).</p>

In response to species-election requirement 1, Applicant elected Species 1A for prosecution in this application. (See Response to Election of Species Requirement dated April 24, 2006.) For the other five species-election requirements, however, the Office had asserted that Applicant constructively elected Species 2A, Species 3A, Species 4A, Species 5A, and Species 6A for prosecution in this application. These elections should have resulted in withdrawal of only claims 90, 98, 104, 108, 115, 118, 119, 133, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 204, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 267, 278, 282, 287, 289, and 314-319. All of the other claims (including those claims that were not subject to any of the species-election requirements) should have remained in the application for examination. Thus, Applicant respectfully requests reinstatement and examination of each of the improperly withdrawn claims identified above.

Objection to Drawings

In the Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a), asserting that "the back face of the at least one notch [being] defined by bristles having varying lengths," as recited in claims 84 and 127, must be shown in the drawings. (Office Action at 2.) Applicant respectfully traverses this objection because the recited feature is clearly shown in the drawings:

For example, Figs. 1A, 2, 3, 7, and 10 illustrate various embodiments where the bristles defining the back face have varying lengths along an axis of the brush. As described in the specification (e.g., col. 4, lines 6-9), in the exemplary embodiment of Fig. 1A, the surface of the brush (which includes the back faces) has generatrices converging to a fixed point P, such that the lengths of the bristles that define the back

faces vary along the axis of the brush. Also, Figs. 1A, 1B, 2-5, 7, 8, 10, and 11 show that the lengths of the bristles that define the back face of a notch vary along a circumferential direction about the axis of the brush. The specification thus discloses "the back face of the at least one notch [being] defined by bristles having varying lengths," as recited in claims 84 and 127.

For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings.

35 U.S.C. § 112, First Paragraph, Rejection

The Examiner rejected claims 84 and 127 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that "the back face of the at least one notch [being] defined by bristles having varying lengths," as recited in claims 84 and 127, was not described in the specification and, therefore, constitutes new matter. (Office Action at 3.) Applicant respectfully traverses this rejection.

As explained above, the originally filed drawings clearly show the recited feature. Under the law of written description, an applicant may show possession of the claimed invention by describing it using, inter alia, such descriptive means as structures, figures, and diagrams that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997). See also M.P.E.P. § 2163. Since the original disclosure fully supports this feature of claims 84 and 127, they satisfy the written description requirements under 35 U.S.C. § 112, first paragraph. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, Second Paragraph, Rejection

The Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168, and 169 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. (Office Action at 4.) Specifically, the Examiner asserted that the recitation of “the back face of the at least one notch [being] defined by bristles having varying lengths” renders the claims indefinite, because the claimed subject matter allegedly has no support in the specification. Applicant respectfully traverses this rejection.

As explained above, the original disclosure, which includes the drawings, fully supports this claimed feature. Therefore, Applicant respectfully requests withdrawal of this rejection.

Moreover, 35 U.S.C. § 112, second paragraph, is not a proper basis for a rejection based on alleged lack of support. A claim term is not indefinite if the meaning of the claim term is discernible. See, e.g., Bancorp Services, L.L.C. v. Hartford Life Ins. Co., 359 F.3d 1367, 1372 (Fed. Cir. 2004) (holding that the disputed claim term, which was not used in the specification, was discernible and hence not indefinite because “the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence”). Since the Examiner’s rejection under § 112, second paragraph, appears to be based solely on the incorrect assertion that the claimed feature lacks written-description support, and not based on indefiniteness, this rejection should be withdrawn for this additional reason.

35 U.S.C. § 102(b) Rejection

The Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 221-233, 262-266, 294, and 295 under 35 U.S.C. § 102(b), as being anticipated by U.S.

Patent No. 4,403,624 to Montgomery ("Montgomery"). Applicant respectfully traverses this rejection.

Montgomery discloses applicators for applying cosmetics, such as mascara, to the eye lashes. The Examiner's rejection relied on the embodiment shown in Figs. 11-13, which discloses an applicator that includes a handle portion 26, a rod 28 extending from the handle portion 26, and a brush portion located on an end of the handle portion 26. The brush portion includes teeth 66" affixed to the rod 28. As shown in Fig. 13, a portion of the teeth 66" extends radially around a bottom half of the rod 28, and the remaining portion of the teeth 66" extends vertically, parallel to one another, from a top half of the rod 28.

The Examiner asserted that the handle portion 26 and the teeth 66" of Montgomery correspond to the recited "elongated core" and "bristles," respectively. The Examiner also asserted that the claimed "at least one notch on the external surface of the brush" is "constitute[d] by the gap between the bristles as shown in Fig. 13." (Office Action at 5.)

As explained below, Montgomery does not disclose or otherwise suggest the subject matter of independent claims 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335.¹

Each of independent claims 84, 127, 170, and 233 recites, among other things, "ends of said bristles defining an external surface of the brush" and "at least one notch on the external surface of the brush, the at least one notch comprising a front face and

¹ As explained above, the Office Action failed to address claims 332-335.

a back face, ... wherein the front and back faces ... intersect one another at a trough line." Similarly, each of independent claims 201, 264, 332, 333, 334, and 335 recites, among other things, "ends of said bristles defining an external surface of the brush," and "at least two notches on the external surface of the brush, the at least two notches each comprising a front face, a back face, and a trough line, ... wherein the front and back faces ... intersect one another at the trough line."

The Montgomery reference fails to teach or suggest each of these features. Although the Examiner asserts that the gap between the teeth 66" of Montgomery corresponds to the recited "notch," and that "the line that divides the [teeth 66]" as shown in Fig. 13" corresponds to the recited "trough line," Applicant respectfully disagrees with these assertions. As an initial matter, the "gap" between the teeth 66" of Montgomery, as identified by the Examiner, is not on an "external surface of the brush" (defined by ends of the bristles of the brush), as recited in the claims. Accordingly, the Examiner's "gap" in Montgomery does not correspond to the recited "notch."

Moreover, contrary to the Examiner's assertion, Montgomery fails to teach or suggest that the front and back faces of a notch "intersect one another at a trough line," as recited in each of the claims. While the Examiner has asserted that, in Montgomery, this feature is "constituted by the line that divides the bristles as shown in Fig. 13)" (Office Action at 6), the Examiner has failed to identify where Montgomery discloses any such "line that divides the bristles," or where Montgomery discloses that front and back faces of a notch "intersect one another" at a trough line, as recited in the claims. Applicant respectfully submits that Montgomery fails to teach or suggest these claimed features.

For at least these reasons, each of the independent claims, and their respective dependent claims, patentably distinguish from Montgomery. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Montgomery.

Conclusion

Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding objection and rejections, and allowance of pending claims 1-335.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to necessarily subscribe automatically to any statement or characterization in that Office Action, regardless of whether it is addressed above.

In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

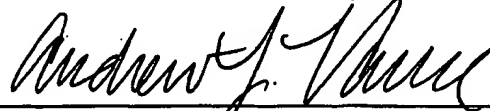
Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 14, 2006

By:



Andrew J. Varice
Reg. No. 45,174

REMARKS

By this Amendment, claims 84, 127, 170, 201, 233, 264, and 332-335 have been amended to recite that the trough line is "spaced away from the core." In addition, new claims 336-339 are added. Support for the amended and new claims can be found in the original specification, drawings, and/or claims (e.g., Figs. 1A, 2, 3, 6-8, 10, and 11; and claims 96, 139, 175, 208, 238, and 271).

Consequently, claims 1-339 are pending in the application, with claims 1, 24, 26, 27, 28, 84, 127, 170, 201, 233, 264, 332, 333, 334, and 335 being independent. Of those pending claims, claims 1-83, 296-301, 308-313, and 320-325 have been allowed. In addition, claims 85-87, 90-124, 128-130, 133-167, 171-198, 204-230, 234-261, 267-293, 302-307, 314-319, and 326-331 have been withdrawn from consideration, as being allegedly drawn to non-elected species.

As an initial matter, Applicant wishes to express sincere appreciation to the Examiner for the courtesy extended to Applicant's representative during the personal interview held on April 23, 2007. At the interview, all of the objection and rejections outstanding in the February 16, 2007 Office Action were discussed. The following remarks reflect the subject matter discussed during the interview.

Improperly Withdrawn Claims

Applicant respectfully submits that the withdrawal of at least claims 85-87, 91-97, 99-103, 105-107, 109-114, 116, 117, 120-124, 128-130, 134-140, 142-146, 148-150, 152-157, 159-160, 163-167, 171-176, 178-181, 183-185, 187-190, 192, 194-198, 205-209, 211-214, 216-218, 220-223, 225, 227-230, 234-239, 241-244, 246-248, 250-253, 255, 257-261, 268-277, 279-281, 283-286, 288, 290-293, 302-307, and 326-331 is

improper, because these claims either read on the elected species or were not subject to any of the species-election requirements applied in the Office Action dated March 22, 2006.

More specifically, in the Office Action dated March 22, 2006, the Office applied the following six species-election requirements:

1	<u>1A</u> : a wherein the "another" notch is the "second" notch (claims 89, 132, 203, and 266); and <u>1B</u> : a wherein the "another" notch is not the "second" notch (claims 90, 133, 204, and 267).
2	<u>2A</u> : a wherein the faces of the notch extend from one end of the brush to the other (original claim 4); and <u>2B</u> : a where the faces of the notch extend along only a part of a length of the brush (claims 98, 141, 177, 210, and 240).
3	<u>3A</u> : a wherein the notch back is convex (original claim 19); and <u>3B</u> : a where the notch back is planar (claims 104, 147, 182, 215, 245, and 278).
4	<u>4A</u> : a directed to the brush shape shown in Figs. 1A, 2, and 3 (original claim 10); <u>4B</u> : a directed to the brush shape shown in Fig. 6; <u>4C</u> : a directed to the brush shape shown in Fig. 7; <u>4D</u> : a directed to the brush shape shown in Fig. 8; <u>4E</u> : a directed to the brush shape shown in Fig. 9; and <u>4F</u> : a directed to the brush shape shown in Fig. 10.
5	<u>5A</u> : a wherein the trough line is straight (original claim 15); and <u>5B</u> : a wherein the trough line is curved (claims 115, 158, 191, 224, 254, and 287).
6	<u>6A</u> : a wherein the peak ridge is straight (original claim 18); and <u>6B</u> : a where the peak ridge is curved (claims 118, 119, 161, 162, 193, 226, 256, and 289).

In response to species-election requirement 1, Applicant elected Species 1A for prosecution in this application. (See Response to Election of Species Requirement dated April 24, 2006.) For the other five species-election requirements, however, the Office had asserted that Applicant constructively elected Species 2A, Species 3A, Species 4A, Species 5A, and Species 6A for prosecution in this application. These

elections should have resulted in withdrawal of only claims 90, 98, 104, 108, 115, 118, 119, 133, 141, 147, 151, 158, 161, 162, 177, 182, 186, 191, 193, 204, 210, 215, 219, 224, 226, 240, 245, 249, 254, 256, 267, 278, 282, 287, 289, and 314-319. All of the other claims (including those claims that were not subject to any of the species-election requirements) should have remained in the application for examination.

For at least these reasons, Applicant respectfully requests reinstatement and examination of each of the improperly withdrawn claims identified above. Should the Examiner continue to withdraw those claims from consideration, Applicant respectfully requests that the Examiner make the claim withdrawal final, while also acknowledging Applicant's traversal, so that Applicant will be entitled to file a petition to the Group Director seeking review of the Examiner's claim withdrawal.

Objection to Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a), asserting that "the back face of the at least one notch [being] defined by bristles having varying lengths," as recited in claims 84 and 127, must be shown in the drawings. During the interview, the Examiner agreed to withdraw this objection because no additional drawing is needed.

35 U.S.C. § 112, First and Second Paragraph, Rejections

The Examiner rejected claims 84 and 127 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In addition, the Examiner rejected claims 84, 88, 89, 125-127, 131, 132, 168, and 169 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. During the interview, the

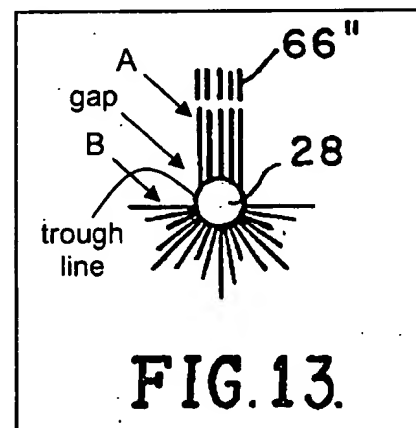
Examiner agreed to withdraw these rejections because the claims fully comply with the requirements of 35 U.S.C. § 112, first and second paragraphs.

35 U.S.C. § 102(b) Rejection

Claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295, and 332-335 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 4,403,624 to Montgomery ("Montgomery").

Although Applicant does not necessarily agree with the Examiner's apparent characterization of the claims and the alleged teachings of Montgomery, Applicant has amended each of independent claims 84, 127, 170, 201, 233, 264, and 332-335 to recite that the trough line at which the front and back faces intersect is "spaced away from the core." As detailed below, this recitation further patentably distinguishes the claimed subject matter from Montgomery.

Montgomery discloses applicators for applying cosmetics to the eye lashes. The Examiner's rejection relied on the embodiment shown in Figs. 11-13, which discloses an applicator that includes a handle portion 26, a rod 28 extending from the handle portion 26, and a brush portion located on an end of the handle portion 26. The brush portion includes teeth 66" affixed to the rod 28. The Examiner asserted that the handle portion 26 and the teeth 66" of Montgomery correspond to the recited "elongated core" and "bristles," respectively. In addition, as clarified by the Examiner during the interview and depicted accordingly in annotated Fig. 13 on the right, the Examiner asserted



that "the gap between the bristles" corresponds to the recited "notch" and that the side faces of the teeth 66" (see "A" and "B" shown in annotated Fig. 13) correspond to the recited "front face" and "back face," respectively. Also, the Examiner asserted that side faces "A" and "B" intersect one another at "the line that divides the bristles."

Without necessarily acquiescing to the Examiner's characterizations of Montgomery, Applicant submits that, even assuming, *arguendo*, that side faces "A" and "B" intersect at "the line that divides the bristles," that line is not "spaced away from the core," as recited in each of independent claims 84, 127, 170, 201, 233, 264, and 332-335. Instead, the alleged "line that divides the bristles" is on the rod 28, as clearly shown in Fig. 13.

For at least this reason, Applicant respectfully submits that each of the independent claims, and their respective dependent claims, patentably distinguish from Montgomery. Thus, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Montgomery.

Conclusion

Applicant respectfully requests reconsideration of this application, withdrawal of all of the outstanding objection and rejections, and allowance of pending claims 1-339.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to subscribe automatically to any statement or characterization in that Office Action, regardless of whether it is addressed above.

Should the Examiner wish to discuss this case, he is invited to call the undersigned at 571-203-2774.

Please grant any extensions of time required to enter this Amendment and
charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 16, 2007

By: *Anthony M. Gutowski* (Reg. No. 50,585)
for Anthony M. Gutowski
Reg. No. 38,742



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,182	07/06/2001	Jean-Louis H. Gucret	5725.0701	9798
22852	7590	02/16/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER HUYNH, KHOA D	
			ART UNIT	PAPER NUMBER
			3751	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/899,182	Applicant(s) GUERET, JEAN-LOUIS H.	
	Examiner Khoa D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-335 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-83, 296-301, 308-313 and 320-325 is/are allowed.
- 6) ☒ Claim(s) 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295 and 332-335 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 85-87, 90-124, 128-130, 133-167, 171-198, 204-230, 234-261, 267-293, 302-307, 314-319 and 326-331.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the back face of the at least one notch is defined by bristles having varying lengths as recited in claims 84 and 127 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 84 and 127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Both claims 84 and 127 recite the limitation "the back face of the at least one notch is defined by bristles having varying lengths". However, such claimed subject matter was not described in the original specification. In the original instant disclosure, applicant discloses (col. 3, lines 6-11) that the bristles of the brushes may be of any type: bristles with different heights, different diameters or cross-sections and made of different materials. Nevertheless, the original disclosure does not disclose that the back face of the at least one notch is defined by bristles having varying lengths. Therefore, claims 84 and 127 contain subject matter that constitutes new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 84, 88, 89, 125-127, 131, 132, 168 and 169 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Both claims 84 and 127 recite the limitations "the back face of the at least one notch is defined by bristles having varying lengths". However, such recitations render the claims indefinite because the claimed subject matter does not have any support in the instant specification. Since the claims do not clearly set forth the metes and bounds of the patent protection desired, the scope of the claims is unascertainable. Claims 88, 89, 125, 126, 131, 132, 168 and 169 depend on claims 84 and 127 and are likewise indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 84, 88, 89, 125-127, 131, 132, 168-170, 199-203, 231-233, 262-266, 294, 295 and 332-335, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Montgomery (4403624).

Regarding claim 84, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constituted by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one

notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 88 and 89, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 125 and 126, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 127, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core,

wherein the back face of the at least one notch is defined by bristles having varying lengths (Fig. 13).

Regarding claims 131 and 132, wherein the at least one notch comprises at least two notches (one on each side as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, and wherein the back face of the one notch intersects with an outer edge of the front face of another notch, wherein the another notch is the second notch.

Regarding claims 168 and 169, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 170, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constitute by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the

back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 199 and 200, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 201, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 202 and 203, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 231 and 232, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 233, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. At least one notch (constituted by the gap between the bristles as shown in Fig. 13) forms on the external surface of the brush. The at least one notch comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the at least one notch intersect one another at a trough line (constituted by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the envelope surface of the brush, wherein the back face of the at least one notch intersects with the envelope surface of the brush.

Regarding claims 262 and 263, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Regarding claim 264, the Montgomery reference discloses a brush. The brush comprises an elongate core (28) and bristles (66") extending from the core, wherein ends of the bristles defining an external surface of the brush, wherein the ends of the longest of the bristles defining an envelope surface of the brush. Two notches (constitute by the gaps between the bristles as shown in Fig. 13) form on the external surface of the brush. Each of the two notches comprises a front face and a back face, wherein the back face being at least in part non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line (constitute by the line that divides the bristles as shown in Fig. 13), wherein the trough line extending in a direction non-perpendicular to the length of the elongate core, wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch.

Regarding claims 265 and 266, wherein the front and back faces of the two notches are separate and continuous surfaces, wherein another notch is the second notch.

Regarding claims 294 and 295, the Montgomery reference discloses a make-up device having a reservoir (22) for containing a make-up product such as mascara, a wiping member (40,50) associated with the reservoir and a brush as discussed supra.

Each of claims 332-335 recites limitations that are substantially similar to the limitations of claims 84, 127, 170, 201, 233 and 264 which have been rejected as discussed supra.

Allowable Subject Matter

8. Claims 1-29 (previously allowed claims), 30-83, 296-301, 308-313 and 320-325 (newly added dependent claims that depend on claims 1-29) are allowed over the prior art of record.

Response to Amendment

9. Applicant's amendment, filed on 11/14/06, to the pending claims is insufficient to distinguish the claimed invention from the cited prior art or overcome the rejections as discussed above.

Response to Arguments

10. Applicant's arguments filed on 11/14/06 with respect to the pending claims have been fully considered. However, such arguments are deemed not persuasive.

Regarding the drawings objection and 112, first paragraph, rejection, applicant, in the arguments, indicates that the embodiment of Fig. 1A and the specification, column 4, lines 6-9, disclose "the back face of the at least one notch is defined by bristles having varying lengths" as recited in claims 84 and 127. Nevertheless, after full reviewed of the instant specification, especially column 4, lines 6-9 and Fig. 1A, it is noted that such claimed subject matter was not described in the original specification. In other words, the original disclosure does not disclose that the back face of the at

least one notch is defined by bristles having varying lengths. Therefore, claims 84 and 127 contain subject matter that constitutes new matter.

Applicant also asserts that the Montgomery reference does not teach the features as claimed in the independent claims. See remarks section, pages 63-64. The examiner disagrees. As stated in the above rejection, the Montgomery reference does teach a brush having an elongate core and bristles extending from the core, two notches formed on the external surface of the brush, wherein each of the two notches comprises a front face and a back face, wherein the back face being non-concave and asymmetric with respect to the front face, wherein the front and back faces of the notches intersect one another at a trough line, wherein an outer edge of the front face of one notch intersects with the back face of a second notch, wherein the back face of the one notch intersects with an outer edge of the front face of another notch. Since the Montgomery reference does disclose each of the claimed features, Montgomery does suggest applicant's invention as claimed.

Applicant also asserts that the gap between elements 66" of Montgomery is not on an external surface of the brush. The examiner disagrees. As shown in Figure 13 of Montgomery, the notch (constitute by the gap between the bristles as shown in Fig. 13) does form on the external surface of the brush. Accordingly, the Montgomery gap does correspond to the recited "notch".

Since Montgomery does teach a brush having all features as claimed in the independent and dependent claims, the rejection based on Montgomery is proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoa D. Huynh
Primary Examiner
Art Unit 3751